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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/770,937
Filing Date: February 02, 2004
Appellant(s): GROSS, JOHN N.

MAILED

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GROUP 3600

J. Nicholas Gross
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2008 appealing from the Office action mailed July 11, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claim 9 is rejected under § 103 as obvious over Hastings and Ostrom, and further in view of Postelnik, but claims 10 and 11 are rejected under § 103 as obvious over Hastings, Ostrom, Postelnik, and official notice (not just Postelnik).

There is also some ambiguity in Appellant's repeated use of the phrase "unpatentable under § 103 in light of the above and further in view of". In the cases of claims 5, 6, 16, 20, 21, 25, 26, 27, 32, 33, and 34, this means unpatentable under § 103

in light of Hastings and Ostrom, and further in view of the additional prior art or official notice cited. However, claim 12 rejected under § 103 as obvious over Hastings, Ostrom, Postelnik, and Jacobi. Claim 13 is rejected under § 103 as obvious over Hastings, Ostrom, Postelnik, Jacobi, and Davis. Claim 14 is rejected under § 103 as obvious over Hastings, Ostrom, Postelnik, Jacobi, and Nakagawa.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,584,450	Hastings et al.	6-2003
2003/0023743	Raphel et al.	1-2003
6,105,021	Berstis	8-2000
2006/0218054	Postelnik et al.	9-2006
6,317,722	Jacobi et al.	11-2001
6,105,006	Davis et al.	8-2000
2002/0046129	Nakagawa	4-2002
2001/0014145	Kamel et al.	8-2001
6,370,513	Kolawa et al.	4-2002

Ostrom, M.A., "With Newer Releases, Netflix Users Can Anticipate a 'Very Long Wait'", The Mercury News, July 7, 2002.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-34

Claims 1, 2, 3, 4, 7, 8, 15, 17, 18, 19, 22, 23, 24, 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (U.S. Patent 6,584,450) in view of Ostrom ("With Newer Releases, Netflix Users Can Anticipate a 'Very Long Wait'"). As per claim 1, Hastings discloses a method of distributing playable media items over an electronic network from a first computer maintained by a provider of a media distribution service to a device used by a subscriber of such service, the playable media items corresponding to machine readable media readable by a subscriber machine player, the method comprising the steps of: (a) setting up a subscriber delivery queue for the subscriber to be controlled by the first computer, said subscriber delivery queue consisting of an ordered list of one or more playable media items to be delivered to the subscriber in a subscriber-defined priority, wherein said subscriber delivery queue is set up at least in part in response to item selection directions provided by the subscriber over the network (column 4, lines 14-34; column 9, line 47, through column 10, line 14; Figure 7; column 11, line 49, through column 13,

line 53); (b) setting up queue replenishment rules for the subscriber delivery queue; and (c) monitoring said subscriber delivery queue in accordance with said queue replenishment rules; wherein said subscriber delivery queue is maintained automatically for the subscriber so as to include at least one playable media item which could be delivered to such subscriber (ibid.). Between the teaching of Hastings that the customer provides movie selection criteria (column 9, line 47, through column 10, line 14), and the teachings of a first computer carrying out operations (column 11, line 49, through column 13, line 53) and delivering products to subscribers (column 8, line 6, through column 9, line 39), automatically determining with the first computer if an additional media item should be added to the subscriber delivery queue is obvious and implied. Hastings does not expressly disclose a second computer used by the subscriber, but the disclosure of Internet communication and a web browser (e.g., column 9, lines 47-62) implies such a second computer. Selecting more movies in accordance with the queue replenishment rules implies modifying the subscriber delivery queue to generate a new ordered list of one or more playable media items (e.g., to include a new release with the subscriber's favorite stars, which is adding an additional playable media item), Hastings does not disclose (d) automatically modifying the subscriber delivery queue with said first computer to generate a new ordered list of one or more playable media items in response to the subscriber confirming that said additional playable media item can be included in the subscriber delivery queue. However, Ostrom teaches modifying the subscriber queue based on a confirmation from the subscriber to assure that new releases be included at the top (paragraph beginning, "Selecting from Nearly 12,000

Titles"), and Hastings teaches the first computer automatically carrying out operations (column 11, line 49, through column 13, line 53). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the stated advantage of ensuring subscribers that they will receive new releases (or other preferred movies, presumably).

As per claim 2, there is no suggestion in Hastings that the subscriber needs to be connected while the computer performs step (c).

As per claim 3, Ostrom teaches subscribers reordering their delivery sequences, implying such an ordered list from a first item to a last (ibid.).

As per claim 4, Ostrom teaches the additional playable media item being inserted in a subscriber-defined delivery order position (ibid.), and given the teaching of Hastings of a computer carrying out operations (column 11, line 49, through column 13, line 53), doing this automatically is held to be obvious and implied.

As per claim 7, Hastings discloses delivering the new playable media items to the subscriber (ibid.).

As per claim 8, Hastings does not expressly disclose that step (d) is performed automatically with sending a further notification to the subscriber, but there is no disclosure that a further notification to the subscriber is sent, and the teaching of Ostrom that most users don't remember which movies are on the top of their lists anyway (bottom paragraph on first page) implies that subscribers are not notified.

As per claim 15, Hastings discloses a trigger event to determine delivery of an item to a subscriber (column 5, lines 1-14; column 14, lines 1-17), which implies modifying the subscriber delivery queue (at least by deleting the item now delivered).

As per claim 17, Hastings discloses a determination by an item recommendation system that an additional playable media item should be added to the subscriber delivery queue as a recommended playable item (ibid., as applied to claim 1), implying a trigger event associated with such a determination (e.g., when a new movie with a subscriber's favorite actor is released).

As per claim 18, Ostrom discloses that the recommended playable media item can be designated as the next to be delivered from the subscriber delivery queue (ibid., as applied to claim 1).

As per claim 19, Hastings discloses that the additional playable media item is determined by a recommender system of the media distribution service which automatically identifies items of interest based on a subscriber preference profile (ibid., as applied to claim 1).

As per claim 22, Hastings discloses that queue replenishment control rules for the subscriber delivery queue can be set up automatically for the subscriber based on an evaluation of item preferences determined for the subscriber (column 9, line 63, through column 10, line 14).

As per claim 23, Hastings discloses that queue replenishment control rules for the subscriber delivery queue can be set up by the subscriber (column 9, line 63, through column 10, line 14).

As per claim 24, Hastings does not expressly describe moving an item from the subscriber to a shipping queue when the subscriber is eligible to receive an additional item, but does disclose shipping items to subscribers, and, once shipped, the items would presumably not remain on the queue of items to be delivered, so defining the record where the items would then be listed as a shipping queue is trivial.

As per claim 28, Hastings discloses that the media distribution service distributes movies to subscribers (ibid.)

As per claim 29, Hastings discloses that the media distribution service is an Internet based movie rental service, and the playable media items are recordings of movies that are mailed to subscribers (ibid., and column 10, lines 29-41).

As per claim 30, Hastings discloses that the subscriber can have a predetermined number of recordings checked out, by implication for a flat fee (columns 5 and 6, "MAX OUT").

As per claim 31, Hastings discloses that a subscriber is charged an additional fee when an additional playable media item is distributed (column 6, lines 14-29).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 3 above, and further in view of Raphel et al. (U.S. Patent Application Publication 2003/0023743). Hastings does not disclose automatically inserting an additional item as the first item to be delivered, but it is well known to add items to the top of a list, as taught, for example, by Raphel (paragraph 61). Hence, it would have been obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention to do so, for the obvious advantage of making an especially desired item available as soon as possible.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 3 above, and further in view of Berstis (U.S. Patent 6,105,021). Hastings does not disclose automatically inserting an additional item as the last item to be delivered, but it is well known to add items to the bottom of a list, as taught, for example, by Berstis (column 8, lines 40-45). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of enabling higher-priority items to be delivered first.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 1 above, and further in view of Postelnik et al. (U.S. Patent Application Publication 2006/0218054). Hastings does not disclose sending a notification to the subscriber after step (c) when the queue replenishment control rules determine that the subscriber delivery queue should be modified, but it is well known to send customers notifications of pending deliveries, modifications to their orders, etc., as taught, for example, by Postelnik (paragraph 74). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to send such a notification, for such obvious advantages as assuring a subscriber of the imminent shipment of desired items, or enabling a subscriber to modify his preference list to receive a more desired item (as set forth in Ostrom).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings, Ostrom, and Postelnik as applied to claim 9 above, and further in view of official notice. As per claim 10, official notice is taken that sending notification that something should be done, or has been done, does not necessarily trigger doing it. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the notification not to automatically trigger a modification of the subscriber delivery queue, for the obvious advantage of not changing the queue of whose current state notification had just been sent.

As per claim 11, Hastings discloses modifying the subscriber delivery queue in accordance with queue replenishment rules (ibid., as applied to claim 1 above), and if one is modifying the queue, and sending a notification, sending a notification of how one is modifying the queue is trivial. (This particular information could be considered non-functional descriptive material in any case.)

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings, Ostrom, and Postelnik as applied to claim 9 above, and further in view of Jacobi et al. (U.S. Patent 6,317,722). Hastings discloses modifying the subscriber delivery queue in accordance with queue replenishment rules (ibid., as applied to claim 1 above), and if one is modifying the queue, and sending a notification, sending a notification of how one is modifying the queue is trivial. Hastings does not disclose that the notification includes an embedded uniform resource link (URL) or an electronic response field in the notification so as to allow the subscriber to review playable media title recommendations from a recommender system, but Jacobi teaches notifications

including hyperlinks to allow a user to review recommendations from a recommender system (column 10, lines 54-62). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the notification to include an embedded uniform resource link (URL) or an electronic response field, for the obvious advantage of profiting from selling (or renting) items to the subscriber that the subscriber is likely to be interested in.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings, Ostrom, Postelnik, and Jacobi as applied to claim 12 above, and further in view of Davis et al. (U. S. Patent 6,105,006). Hastings does not disclose that the subscriber delivery queue is automatically modified in accordance with the queue replenishment rules after a predefined time delay, but it is well known to take action after a predefined time delay, as taught, for example, by Davis (column 23, lines 16-26). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the subscriber delivery queue to be automatically modified in accordance with the queue replenishment rules after a predefined time delay, for at least the obvious advantage of giving someone (the subscriber, or an administrator), time to make any manual modification which seem indicated.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings, Ostrom, and Postelnik as applied to claim 9 above, and further in view of Nakagawa (U.S. Patent Application Publication 2002/0046129). Hastings does not disclose that the notification provides directions for the subscriber to accept and/or

modify said additional playable media item, but Ostrom, as noted, discloses the subscriber modifying (or, by default, accepting) a list, and it is well known to provide directions, as taught, for example, by Nakagawa (display of directions in paragraph 41). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to provide such directions, for the obvious advantage of enabling the subscriber to readily modify (or accept) the queue according to his wishes.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 15 above, and further in view of Kamel et al. (U.S. Patent Application Publication 2001/0014145). Hastings does not disclose that the trigger event is associated with a quantity of playable media items remaining in said subscriber delivery queue, but a trigger event could be associated with a quantity of playable media items remaining in the delivery queue in several ways (e.g., the queue might have become too large or too small), and it is well known at least to add additional items to a queue which has become too small, as taught, for example, by Kamel (paragraphs 161, 162, 167, and 168). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the trigger event to be associated with a quantity of playable media items remaining in said subscriber delivery queue, for the obvious advantage of assuring an adequate quantity of playable media items in the queue.

Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 19 above, and further in view of official

notice. Hastings does not disclose processing an item rating survey provided by the subscriber to determine a subscriber item preference profile suitable for use by the recommender system, but official notice is taken that it is well known to process item rating surveys to determine preference profiles for use in recommending items. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of recommending items likely to be of interest to subscribers, and thus making subscriptions more attractive, and collecting corresponding fees.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 1 above, and further in view of official notice. As per claim 21, Hastings does not disclose that the additional playable media item is randomly selected from a list of playable media items associated with a category selected by the user, although Hastings discloses the user selecting a category (column 8, lines 6-65). However, official notice is taken that it is well known to select an item at random from a list. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of providing a recommended item that would have had to be chosen somehow, perhaps in the absence of any particular known reason to choose one item from a category rather than another.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 1 above, and further in view of official notice. Hastings does not disclose receiving subscriber feedback concerning selection of said additional

playable media item, but official notice is taken that it is well known to receive feedback from subscribers or other customers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so for the obvious advantage of recommending items likely to be of interest to subscribers, and thus making subscriptions more attractive, and collecting corresponding fees.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 1 above, and further in view of official notice. Hastings does not disclose that a subscriber is charged a fee when an additional playable media item is moved to the subscriber delivery queue, but official notice is taken that it is well known to charge fees for various services or at various steps of a process. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of profiting from such fees.

Claims 32, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings and Ostrom as applied to claim 28 above, and further in view of official notice. Hastings does not disclose that the movies are distributed electronically to the subscribers, or that the delivery is by satellite transmission or broadband Internet-based connection, but official notice is taken that it is well known to distribute movies, electronically, by satellite transmission, or by broadband Internet-based connection. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious

advantage of getting movies to customers without the delays of mailing or physical delivery.

Claim 35

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (U.S. Patent 6,584,450) in view of Ostrom ("With Newer Releases, Netflix Users Can Anticipate a 'Very Long Wait'"). Hastings discloses a method of distributing playable media items comprising the steps of: (a) setting up a subscriber selection queue for the subscriber to be controlled by the first computer, said subscriber selection queue consisting of a list of one or more playable media items; wherein said subscriber selection queue is set up at least in part in response to item selection directions provided by the subscriber; (b) setting up queue replenishment control rules for the subscriber selection queue; and (c) monitoring said subscriber selection queue in accordance with the queue replenishment control rules to determine if changes should be made to the subscriber selection queue; wherein said subscriber delivery queue is maintained automatically for the subscriber to include at least one playable media item which could be delivered to such subscriber (column 4, lines 14-34; column 9, line 47, through column 10, line 14). Between the teaching of Hastings that the customer provides movie selection criteria (column 9, line 47, through column 10, line 14), and the teachings of a first computer carrying out operations (column 11, line 49, through column 13, line 53) and delivering products to subscribers (column 8, line 6, through column 9, line 39), automatically determining with the first computer if changes should be made to the subscriber selection queue is obvious and implied. It is likewise obvious

for the monitoring to include analyzing the content and/or characteristics of other playable media items within the selection queue to determine the changes, so as to accomplish the disclosed purpose of provide the subscriber with movies according his selected criteria, as taught by Hastings. Hastings discloses modifying the subscriber selection queue to generate a new list of one or more playable media items (ibid., the generation of a new list being implied by the release of new movies with the subscriber's favorite actor or other specified characteristics), but Hastings does not disclose (d) modifying the subscriber selection queue to generate a new list of one or more playable media items based on a confirmation from the subscriber. However, Ostrom teaches modifying the subscriber queue based on a confirmation from the subscriber (paragraph beginning, "Selecting from Nearly 12,000 Titles"), and Hastings teaches a computer automatically carrying out operations (column 11, line 49, through column 13, line 53). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the stated advantage of ensuring subscribers that they will receive new releases (or other preferred movies, presumably).

Claim 36

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (U.S. Patent 6,584,450) in view of Kolawa et al. (U.S. Patent 6,370,513) and official notice. Hastings discloses a method of distributing playable media items over an electronic network to a subscriber of a media rental service, the method comprising the steps of: (a) receiving subscriber preference data for the subscriber during a first data

session network (column 4, lines 14-34; column 9, line 47, through column 10, line 14); (b) generating a subscriber profile for the subscriber suitable for use by a recommender system; and (c) processing said subscriber profile using said recommender system to identify a media item that is likely to be of interest to the subscriber; wherein said media item can be automatically shipped to the subscriber after said first data session, and without requiring a second data session by the subscriber with said media rental service (ibid.; and Figure 7; column 12, lines 21-38). Hastings discloses various options for mailing or shipping the media item to the subscriber, and shipping the item to the subscriber (column 4, lines 22-34), but does not disclose that receiving subscriber preference data includes receiving notification and shipment options, and does not disclose notifying the subscriber. However, official notice is taken that it is well known to receive notification and shipping options (e.g., a mailing address to which an item is to be shipped, whether an item is to be shipped by regular or high-priority delivery, a telephone number or email to which notification is to be sent), and perform notification and/or shipping in accordance with the received option information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive notification and shipment options perform notification and/or shipping in accordance therewith, for such obvious advantages of arranging for shipment to the proper address, notification to assure the subscriber that the media item was on its way, shipment with the degree of priority that the subscriber wanted and was willing to pay for, etc.

Hastings does not expressly disclose (e) repeating step (c) to automatically select and maintain at least one media item, but does disclose providing new releases to subscribers (ibid. and also column 11, lines 26-45), as does Ostrom, which implies repeating step (c) as new releases become available, to determine which subscribers are likely to be interested in which new releases. Hastings does not disclose (f) enabling the subscriber to accept delivery of said at least one additional media item and/or select another media item, but it is well known to enable a customer to accept a recommended item, and/or select another item, as taught, for example, by Kolawa (column 20, lines 7-25). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to enable the subscriber to accept delivery of said at least one additional media item and/or select another media item, for the obvious advantage of providing the subscriber with a media item likely to be to his taste, thereby making people more likely to see subscribing as worth the money.

(10) Response to Argument

The primary question is whether independent claims 1 and 35, together with various dependent claims, are obvious in view of Hastings (a patent assigned to Netflix.com) and Ostrom (an article about Netflix). Secondary questions are whether some of the dependent claims are obvious in view of Hastings, Ostrom, and other prior art, and also whether claim 36 is obvious over Hastings in view of Kolawa. Examiner maintains that all of the claims are obvious.

Appellant argues that a deficiency of prior art systems for providing rental items (e.g., the Netflix system for providing movies) is that the user is required to periodically visit and replenish his selection queue in order to keep receiving rental items, in contrast to Appellant's invention, where a queue is automatically replenished. Examiner replies that Hastings in fact discloses, or at least strongly implies, automatic replenishment of a queue (column 9, line 63, through column 10, line 14). Hastings discloses that in addition to identifying particular movie titles, the customer may, for example, specify "types of movies, directors, actors, or any other movie preferences or attributes," whereupon the provider "automatically selects particular titles that satisfy the movie selection criteria." Hastings also discloses the provider computerizing and automating its operations (column 11, line 49, through column 13, line 53). Thus, it does not appear from Hastings that a user would necessarily have to periodically visit and replenish his selection queue, at least not until the provider system had lent him, not only movies he had explicitly selected, but whatever other movies it had which starred the user's favorite actors, were categorized in his preferred type of movies, or otherwise satisfied his chosen movie preferences or attributes.

Specifically regarding claim 1, it is agreed that Hastings does not disclose step (d), automatically modifying the subscriber delivery queue with said first computer to generate a new ordered list of one or more playable media items in response to the subscriber confirming that said additional playable media item can be included in the subscriber delivery queue [emphasis added]. As set forth in the preceding paragraph, Examiner holds that Hastings implies automatically modifying the subscriber delivery

queue by, for example, adding more movies in accordance with a user's selected criteria as movies already on the queue are rented and returned, or as new movies are released and become available to add to people's queues. In column 10, lines 9-14, Hastings discloses that a user's movie selection criteria may specify a preference for "new release" movies, which is highly suggestive of adding such movies to the queue as they are released. Ostrom teaches that Netflix subscribers can reorder their preference lists regularly to assure that the new releases they want stay on top, implying that subscribers could also reorder their preference lists to select other movies to be added to their queues. Appellant states that Ostrom does not disclose automatically determining whether an additional playable media item should be added to the queue, nor automatically modifying the subscriber queue, which is true, although Examiner's position is that Ostrom teaches modifying a user's queue based on a confirmation from the user, and Hastings discloses a computer processing users' queues automatically, making the combination obvious. Examiner believes this position to be supported by the *In re Venner* decision, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), where the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is obvious to one of ordinary skill in the relevant art.

Another consideration is that Appellant's invention might distinguish over the prior art by automating the replenishment of delivery queues, or might distinguish over the prior art by having subscriber involved in confirming items to be added to delivery

queues, but it is difficult to accept that the prior art is deficient in failing to disclose either automation or manual intervention.

Appellant next argues that Hastings does not disclose monitoring the subscriber delivery queue, merely filling the queue with items from manual selections or with items based on subscriber selection criteria. Examiner responds that this depends on what one understands monitoring the subscriber delivery queue to mean. If monitoring the queue must mean specifically monitoring the number of items in the queue, Appellant's contention is true. If monitoring the queue can mean monitoring subscriber selections and criteria associated with the queue, and, by implication, monitoring whether particular items are already in the queue, or have been in the past, then Hastings monitors subscriber delivery queues. Examiner may properly give the broadest reasonable interpretation to claim language in the course of examining claims.

Appellant also argues that Hastings does not disclose that the subscriber delivery queue is maintained automatically for the subscriber so as to include at least one playable media item. Examiner replies that this is the usual effect of the procedures disclosed by Hastings, as cited above, and also by column 11 of Hastings, lines 1-45, where more is said about shipping movies and other items meeting subscribers' selected criteria to the subscribers as they become available. Ostrom also teaches maintaining a queue, although it may be a problem that the most preferred items will not be at the top. Appellant argues that there may be no movies which satisfy the subscriber's selected criteria, or no such movies actually available, and that the Hastings patent makes no mention of how to address this dilemma. Examiner replies

that, in addition to the teachings of the Hastings patent, as discussed above, the Ostrom article is explicit about Netflix providing customized recommendations to customers, and leading customers to movies they might not otherwise have known about (paragraphs beginning, "Netflix doesn't just respond" and "Using a proprietary algorithm-based technology"; the Ostrom article even quotes Mr. Hastings on this). Thus, there will almost certainly be movies which can be recommended to the subscriber, so the problem of the delivery queue containing no items is unlikely to arise, unless, perhaps, the subscriber turns down all recommendations.

Regarding claim 35, Appellant reiterates that this should be allowed for at least the same reasons as claim 1; Examiner reiterates his arguments against claim 1. Appellant further argues that Examiner has made a merely conclusory statement without evidence, in writing:

It is likewise obvious for the monitoring to include analyzing the content and/or characteristics of other playable media items within the selection queue to determine the changes, so as to accomplish the disclosed purpose of provid[ing] the subscriber with movies according his selected criteria, as taught by Hastings.

Examiner replies that this was not an unsupported conclusion, but based upon Hastings's disclosure. Hastings discloses the user providing movie selection criteria such as types of movies, actors, directors, etc. (column 9, line 63, through column 10, line 14). Thus, Hastings's method would have to involve analyzing "other playable media items" to determine what type of movies they were, who the actors and directors

were, etc., in order to accomplish Hastings's disclosed purpose. This conclusion is based on the prior art, not on mere conjecture by Examiner.

Regarding claim 36, Appellant argues that Hastings does not disclose a recommender system. Examiner replies that the disclosed procedure of gathering subscriber profile information on what types of movies the subscriber prefers, and what actors and directors he is interested in, and using this information to provide movies that best satisfy the indicated preferences, meets the limitations of (b) generating a subscriber profile for the subscriber suitable for use by a recommender system, and (c) processing the subscriber profile using the recommender system to identify a media item that is likely to be of interest to the subscriber (column 9, line 63, through column 10, line 14).

Appellant also argues the separate patentability of claim 4, on the grounds that Ostrom is not referring to an additional playable media item, but to a preexisting playable media item. Examiner replies that once a playable media item has been added (as an additional item), a subscriber, in accordance with Ostrom, can give instructions for its delivery order position to be changed or restored as the subscriber sees fit, leading to the playable media item being automatically inserted accordingly.

Appellant argues for claim 9 that Postelnik does not mention notices for a subscriber delivery queue. Examiner replies that Postelnik does not need to disclose notices specifically for a subscriber delivery queue to be pertinent prior art, valid for showing the obviousness of sending notifications. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Appellant calls on the PTO to apply *KSR* consistently; Examiner notes that the Supreme Court has ruled in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). To quote further from *KSR* (at 1386), “[R]igid application of preventative rules that deny fact finders recourse to common sense are neither necessary nor consistent with precedent.” The Court also noted in the *KSR* decision, “[I]f there is design need or market pressure to solve [a] problem, and there are [a] finite number of identified, predictable solutions, [a] person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation.”

Regarding claims 12, 14, and 15, Examiner notes that there were proper statements of motivation, based on the knowledge generally available to one of ordinary skill in the art, to combine references so as to reject claims 12 and 14. No combination or motivation was needed to reject claim 15, since Hastings discloses the limitation recited. Appellant’s argument that the economics of the industry taught away from the present inventions amounts to saying that it would be in a provider’s interest not to provide too many movies to a subscriber. Examiner replies that this might have been in a provider’s short-term interest once the provider had obtained the subscriber’s subscription money, but it would not have been in the provider’s long-term interest if the provider wanted renewals and good word-of-mouth to other potential subscribers.

Regarding claim 13, Appellant argues that Davis makes no mention of a queue, or working with titles. Examiner replies that Davis was made of record as an example of taking action after a predefined time delay, something well known and applicable in a wide variety of contexts. Davis is thus pertinent to applicant's particular problem, as per the *Oetiker* decision.

Similarly regarding claim 16, where Kamel does make reference to queues, contrary to what Appellant states, although admittedly not to playable media items. Examiner maintains that adding additional items to a queue which has become too small is also well known and applicable in a wide variety of contexts, making Kamel pertinent prior art.

As per claim 17 and 19, Examiner has already defended his interpretation of Hastings as disclosing a recommender system, and reiterates what he has set forth above regarding claim 36.

Finally, Appellant argues that Hastings says nothing about bumping a recommended title to the top of the queue. Examiner agrees, which is why Ostrom rather than Hastings is cited in the rejection of claim 18.

Hence, Examiner maintains that the prior art of record makes Appellants claims obvious under 35 U.S.C. 103, as read in light of relevant precedents, and respectfully submits that the rejections can properly be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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